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Fax Transmission

From: **Daniel G. Shanley** Date: **December 7, 2007**
Direct Dial: **202.220.4420** Fax: **202.220.4201**
Client/Matter: **10517/225** Total number of pages:
(including cover)

Please deliver to:

| Name | Company | Fax |
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| Henry C. YUEN Special Programs Examiner | OFFICE OF THE COMMISSIONER FOR PATENTS | 571-273-4856 |

Re: **REQUEST FOR PARTICIPATION IN THE**
PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM
U.S. Patent Application Serial No. 10/811,984
Inventors: **Shigetaka YOSHIKAWA et al.**
Title: ***Mounting Structure and Method for Heat Accumulation Tank***
Our Ref.: **10517/225**

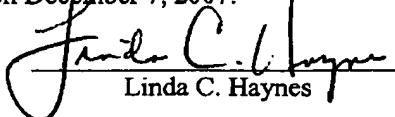
Message:

Mr. Yuen:

Attached are copies of our Response to Decision on Request to Participate in Patent Prosecution Highway Pilot Program and Petition; Certification From Translator regarding accuracy of translation of the Notification Concerning Rejection Reason, in Japanese Application No. 2003-093015; Notification Concerning Rejection Reason, in Japanese Application No. 2003-093015; and Japanese Language Version of the Notification Concerning Rejection Reason, in Japanese Application No. 2003-093015.

CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this Response to Decision on Request for Participate in Patent Prosecution Highway (PPH) Pilot Program and Petition is being facsimile transmitted to the U.S. Patent and Trademark Office, at 571-273-4856, on December 7, 2007.


Linda C. Haynes

☒ Original will not follow ☐ Original will follow by ☐ Regular Mail ☐ Overnight Delivery ☐ Hand Delivery

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PATENT

U.S. Serial No: 10/811,984

Attorney Docket No: 10517/225

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Shigetaka Yoshikawa, *et al.* *Confirmation No. 3140*
Application No: 10/811,984
Filed: March 30, 2004
Group Art Unit: 1723
Examiner: (To Be Assigned)
For: MOUNTING STRUCTURE AND METHOD FOR
HEAT ACCUMULATION TANK

RESPONSE TO DECISION ON REQUEST TO PARTICIPATE
IN PATENT PROSECUTION HIGHWAY PILOT PROGRAM AND PETITION

VIA FACSIMILE AT 571-273-4856
MAIL STOP - PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the Decision on Request to Participate in Patent Prosecution Highway Pilot Program and Petition mailed November 21, 2007, Applicants request a reversal of the dismissal of the request and petition. Specifically, the Decision states therein that the Applicants met all conditions except Item #5, in that Applicants failed to include a copy of the Japanese language Office Action (refusal) and its English translation.

The Submission of Request for Participation in the Patent Prosecution Highway (PPH) Pilot Program submitted on November 2, 2007 presented to the PTO: "Certification From Translator regarding accuracy of translation of the Notification Concerning Rejection Reason, in Japanese Application No. 2003-093015, and "Notification Concerning Rejection Reason, in Japanese Application No. 2003-093015."

PATENTU.S. Serial No: 10/811,984
Attorney Docket No: 10517/225

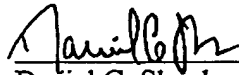
Our review of the file revealed that a copy of the Japanese language version of the Notification Concerning Rejection Reason, in Japanese Application No. 2003-093015, which is the Japanese Office Action, was inadvertently omitted from the submission, even though a copy of the English translation was filed with the submission. To fully meet the conditions of requirement, Applicants now enclose the Japanese Language Version of the Notification Concerning Rejection Reason, in Japanese Application No. 2003-093015. Also, for your ease of reference, Applicants resubmit copies of the Certification From Translator regarding accuracy of translation of the Notification Concerning Rejection Reason, in Japanese Application No. 2003-093015 and the Notification Concerning Rejection Reason, in Japanese Application No. 2003-093015.

By meeting all the conditions to participate in the Patent Prosecution Highway (PPH) pilot program, Applicants respectfully request that the dismissal be reversed and the application be allowed to participate in the PPH pilot program.

Special Programs Examiner Yuen is invited to contact the undersigned at (202) 220-4420 to discuss any matter concerning this application. It is not believed that any further fees are owed, however if additional fees are owed, the Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

Date: December 7, 2007


Daniel G. Shanley
(Reg. No. 54,863)

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Japanese office action

整理番号:PT03-037-T 発送番号:339902 発送日:平成18年 8月 8日 1

拒絶理由通知書

| | |
|----------|----------------------|
| 特許出願の番号 | 特願2003-098016 |
| 起案日 | 平成18年 7月31日 |
| 特許庁審査官 | 栗倉 裕二 3220 3T00 |
| 特許出願人代理人 | 田淵 経雄 様 |
| 適用条文 | 第29条第1項、第29条第2項、第37条 |

この出願は、次の理由によって拒絶をすべきものである。これについて意見があれば、この通知書の発送の日から60日以内に意見書を提出して下さい。

理 由

1. この出願の下記の請求項に係る発明は、その出願前に日本国内又は外国において、頒布された下記の刊行物に記載された発明又は電気通信回線を通じて公衆に利用可能となった発明であるから、特許法第29条第1項第3号に該当し、特許を受けることができない。また、この出願の下記の請求項に係る発明は、その出願前日本国内又は外国において頒布された下記の刊行物に記載された発明又は電気通信回線を通じて公衆に利用可能となった発明に基いて、その出願前にその発明の属する技術の分野における通常の知識を有する者が容易に発明をすることができたものであるから、特許法第29条第2項の規定により特許を受けることができない。

記 (引用文献等については引用文献等一覧参照)

- ・請求項1
- ・引用文献等1
- ・備考

① 引用文献1 (段落【0019】、図4等参照) には、タンク本体を有する蓄熱タンクの被取付け部材への取付け構造であって、タンク本体の胴部に巻付けられた弾性部材と、弾性部材の外周面に巻き付けられ周方向に締め付けられてタンク本体を弾性部材を介して保持し、かつ、被取付け部材に取付けられる取付け部材とを、備えている蓄熱タンクの取付け構造に関する技術が開示されている。

2. この出願は、下記の点で特許法第37条に規定する要件を満たしていない。

記

整理番号:PT03-037-T 発注番号:339902 発注日:平成18年 8月 8日 2

請求項1に記載される発明と請求項2-9に記載される発明に共通する課題は、段落【0004】の記載より、「蓄熱タンクの確実な保持、面圧の均一化、スローリークのおそれの除去」であるが、この課題は、本願出願前に解決されており（例えば、引用文献1等参照）、本願出願時未解決の課題ではないから、両発明は特許法第37条第1号の関係を満たさない。

また、上記両発明に共通する解決しようとする課題に対応した発明特定事項である請求項1に記載の事項は、引用文献1に開示されている通り本願出願前に公知の技術であるから、解決しようとする課題に対応した新規な発明特定事項である主要部が存在せず、上記両発明は、特許法第37条第2号の関係を満たさない。

さらに、上記両発明は、特許法第37条第3号、第4号、第5号に規定する他のいずれの関係も満たさない。

この出願は特許法第37条の規定に違反しているので、請求項1以外の請求項に係る発明については新規性、進歩性等の要件についての審査を行っていない。

引用文献等一覧

1. 特開平06-213116号公報

なお、請求項1に係る発明について、拒絶の理由が新たに発見された場合には拒絶の理由が通知される。

(1) 明細書を補正した場合は、補正により記載を変更した箇所に下線を引くこと（特許法施行規則様式第13備考6）。

(2) 補正は、この出願の出願当初の明細書又は図面に記載した事項のほか、出願当初の明細書又は図面に記載した事項から自明な事項の範囲内で行わなければならない。補正の際には、意見書で、各補正事項について補正が適法なものである理由を、根拠となる出願当初の明細書等の記載箇所を明確に示したうえで主張されたい。（意見書の記載形式は、無効審判における訂正請求書の記載形式を参考にされたい。）

先行技術文献調査結果の記録

| | | | |
|--------|--------|------|-----|
| 調査した分野 | IPC第7版 | F01P | 3/ |
| | | B60H | 1/ |
| | | F02N | 17/ |

この先行技術文献調査結果の記録は、拒絶理由を構成するものではない。

この拒絶理由通知の内容に関するお問合せ、または面接のご希望がございましたら、

整理番号:PT03-037-T 発送番号:339902 発送日:平成18年 8月 8日 3/E

たら下記までご連絡下さい。

特許審査第二部 動力機械 栗倉裕二

TEL. 03 (3581) 1101 内線3395

FAX. 03 (3580) 6904

CERTIFICATION

I, Mitsuyo Noda, of TOYOTA TECHNICAL DEVELOPMENT CORP., 1-21, Imae, Hanamoto-cho, Toyota, Aichi, 470-0334 Japan, hereby certify that I am the translator of the accompanying certified copy of the official communications received from the Japan Patent Office in the patent application identified below, and certify that the following is a true and correct translation to the best of my knowledge and belief.

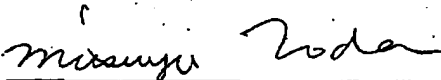
Application Number

Japanese Patent Application

No. 2003-093015

Date of Filing

March 31, 2003

Mitsuyo NodaDated this 9th day of October, 2007



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December 5, 2007

VIA FACSIMILE: 011 81 565 43 2950
(confirmation via airmail)

Mr. Koichi Kato
Toyota Technical Development Corporation
Headquarters Building No.2
1-21 Imae, Hanamoto-cho
Toyota, Aichi, 470-0334, Japan

CONFIRMATION

Re: **URGENT, RESPONSE DUE DECEMBER 21, 2007**
PATENT PROSECUTION HIGHWAY PILOT PROGRAM
U.S. Patent Application Serial No. 10/811,984
Inventors: Shigetaka YOSHIKAWA *et al.*
Title: *Mounting Structure and Method for Heat...*
Client Ref.: TSN 2003-0343-US-00 (TOYOTA)
Your Ref.: TFN 030212-US; Our Ref.: 10517/225

Dear Mr. Kato:

Enclosed for your review and records is a copy of the Decision on Request to Participate in Patent Prosecution Highway Pilot Program and Petition. Unfortunately, at this time, the request and petition are, dismissed.

The request to participate in the PPH pilot program and petition met all conditions except Item #5, which is: **Applicant must submit a copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate.**

Please forward the required documents on or before the **December 21, 2007** response due date. **NO EXTENSION OF TIME IS PERMITTED.** If the deficiencies are not corrected within the time period given, that is, December 21, 2007, the application will await action in its regular turn.

We look forward to receiving the requested documents. Meanwhile, feel free contacting us with any questions or concerns about this or any other matter.

Very truly yours,

KENYON & KENYON LLP

By

A handwritten signature in dark ink, appearing to read 'Daniel G. Shanley', written over a horizontal line.
Daniel G. Shanley

DGS/lch

Enclosure

New York Washington, DC Silicon Valley www.kenyon.com

Reference Number: PT03-037-T
Dispatch Date: August 8, 2006

Dispatch Number: 339902

NOTIFICATION CONCERNING REJECTION REASON

Patent Application Number: Japanese Patent Application No. 2003-093015
Drafting date: July 31, 2006
Examiner of Patent Office: Yuji Awakura 3220 3T00
Representative for Patent Applicant: Tsuneo Tabuchi
Applied Text of Patent Law: Article 29, Paragraph 1; Article 29, Paragraph 2;
Article 37

This application is to be rejected for the reasons described below. If you have an opinion about these reasons, please submit a written opinion within 60 days of the date of transmittal of this notification.

REASONS

1. The invention according to the claims of the present application as described below is an invention described in the following publications, which were distributed in Japan or in a foreign country or an invention that became available to the public through the electric communication line prior to the filing of the application of the present application; and as such, in accordance with Article 29, Paragraph 1, Item 3 of the patent law, cannot be granted a patent. Further, the invention according to the claims of the present application as described below is an invention that could easily have been made, prior to the filing of the patent application, by a person with ordinary skill in the art to which the invention pertains, on the basis of an invention described in the following publications, which were distributed in Japan or in a foreign country or the invention that became available to the public through the electric communication line prior to the filing of the application of the present application; and as such, in accordance with Article 29, Paragraph 2 of the patent law, cannot be granted a patent.

DISCUSSION (Refer to List of Cited References)

Claim: 1

Reference: 1

Remarks

The cited reference 1 (see paragraph [0019] and FIG. 4, etc.) describes the technology related to the structure of a portion at which a heat accumulation tank having a tank main body is mounted to a receiving member. More specifically, the

technology is related to the structure that includes an elastic member, and a mounting member. The elastic member wraps around a body section of the tank main body. The mounting member wraps around the outer peripheral surface of the elastic member and fastened in the circumferential direction, thereby holding the tank main body with the elastic member interposed between the tank main body and the mounting member. Also, the mounting member is attached to the receiving member.

2. The present application does not comply with the requirements defined in Article 37 of the patent law for the reason below.

The objects common to the invention described in claim 1 and the invention described in claims 2 to 9 are considered to be "reliably holding a heat accumulation tank, homogenizing surface pressure, and eliminating a possibility of slow leak", based on the description in paragraph [0004]. However, these objects were already achieved prior to the filing of the present application (for example, see the cited reference 1), and these objects are not the objects unsolved at the time of filing the present application. Therefore, the descriptions in claim 1 and claims 2 to 9 of the present application do not satisfy the relation defined in Article 37, Paragraph 1 of the patent law.

Further, the description in claim 1, which states matters that specify the invention to solve the common problems to claim 1 and claims 2 to 9, describes the technology that has been known at the time of filing the present application, as described in the cited reference 1. Accordingly, the description in claim 1 of the present application does not include a main portion describing new matters that specify the invention to solve the common problems. Accordingly, the descriptions in claim 1 and claims 2-9 do not satisfy the relation defined in Article 37, Paragraph 2, of the patent law.

Further, the descriptions in claim 1 and claims 2 to 9 do not satisfy any other relations defined in Article 37, Paragraphs 3, 4, and 5 of the patent law.

The present application does not comply with the requirements defined in Article 37 of the patent law, and therefore the descriptions in claims other than claim 1 have not been examined for the requirements of novelty and nonobviousness, etc.

List of Cited References

1. Japanese Patent Application Publication No. JP-A-06-213116

If a new rejection reason is found, the applicant will be notified of the rejection reason.

(1) When amendment is made, please underline a portion of description which is changed by amendment (Note 6 of Patent Law Enforcement Rule, Style 13).

(2) The amendment should be made within a scope of matters described in an original specification and drawings at the time of filing, and also within a scope of matters which are obvious based on the matters described in the original specification and drawings at the time of filing. In a written opinion, please assert the reason why each amendment is appropriate, and clearly indicate a portion of description in the original specification at the time of filing, and the like, based on which the assertion is made. (For the written opinion form, please refer to the example form of a request for amendment used in an invalidation trial.)

Record of Results of Searching for Publications disclosing Related Art

| | | |
|------------------|---------------------------------|--------------------------------|
| - Searched Field | IPC the 7 th edition | F01P 3/ B60H 1/ F02N 17/ |
|------------------|---------------------------------|--------------------------------|

This Record of Results of Searching for Publications disclosing Related Art does not constitute any reason for rejection.

Contact address regarding the contents of the Notification Concerning Rejection Reason:

Motive Machinery Examiner: Yuji Awakura

Second Patent Examination Department

Tel: 03-3581-1101 (extension: 3395)

Fax: 03-3580-6904